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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,370	10/21/2003	Matthew T. Adams	13560	7689

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ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

MAYES, MELVIN C

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,370

Applicant(s)

ADAMS ET AL.

Examiner

Melvin Curtis Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

(1)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 10, drawn to a label, classified in class 428, subclass 40.1.
- II. Claims 11 – 17, drawn to a method of concealing data, classified in class 156, subclass 277.
- III. Claims 18 – 19, drawn to a method of concealing data, classified in class 283, subclass 73.

(2)

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process, such as adhesively attaching the label to the composite material to make it integral with the object.

(3)

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

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process can be used to make a materially different product, such as a composite printed with ink instead of having a carrier integral with the composite material.

(4)

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, one being printing a carrier and embedding in composite while the other being printing the composite.

(5)

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

(6)

During a telephone conversation with Catherine Gemrich on April 1, 2005 a provisional election was made with traverse to prosecute the invention of II, claims 11 – 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 – 10 and 18 – 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

(7)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(8)

Claims 13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 16 claim "further comprising the steps of" and depend from Claims 11 and 15 which claim "embedding the carrier in a composite material." How do the further steps of Claims 13 and 16 relate to the steps in Claims 11 and 15? Are these further steps in addition to the step of embedding or describe the step of embedding? If they are in addition to the step of embedding, do the further steps precede or follow the step of embedding. This is not clear.

Claim 15 claims "printing indicia...to obscure the...carrier **except for the indicia.**" It is not clear what is being claimed by printing indicia to not obscure the indicia. How is indicia printed so as to not obscure itself? This is not clear.

Double Patenting

(9)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(10)

Claims 11-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 18 of copending Application No. 10/696,941 in view of Bianco 4,891,254 and Maruyama et al. 5,686,725

Copending Application No. 10/696,941 claims a method of labeling a composite material comprising: obtaining a porous mesh carrier; printing ink indicia on the carrier; and embedding the carrier in a composite material, further comprising placing the printed carrier on the surface of the composite; coating the carrier with resin; and allowing the resin to flow into the mesh.

Copending Application No. 10/696,941 does not claim printing with ink selected from magnetically doped ink or ink with UV or IR components.

Bianco teaches that in embedding identification means in a composite article by placing the printed carrier on a fiberglass base and coating with a layer of epoxy or polyester material so that the carrier becomes an integral part of the fiberglass article, the carrier can be printed with a bar code readable by infrared light.

Maruyama et al. teach that bar codes that are invisible to the naked eye but whose information can be identified by infrared rays are printed with an ink containing indium-tin oxide which is an infrared-absorbing compound (col. 1, lines 14-54).

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It would have been obvious to one of ordinary skill in the art to have modified the method of copending Application No. 10/696,941 for labeling a composite material by printing the carrier with ink that is readable by infrared light, as taught by Bianco, to provide a composite article with identification means in the form of a bar code readable by infrared light. Providing the ink with IR components would have been obvious to one of ordinary skill in the art, as Maruyama et al. teach that bar codes that can be identified by infrared rays, yet invisible to the naked eye, are printed with an ink containing indium-tin oxide which is an infrared-absorbing compound.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

(11)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(12)

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of Maruyama et al. 5,686,725

Bianco discloses a method of embedding identification means in an article comprising: providing a carrier substrate with readable information; placing the carrier substrate on a base such as fiberglass; and coating the carrier substrate and base with a layer of epoxy or polyester material so that the substrate becomes an integral part of the fiberglass article. The carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material. The identification means on the carrier substrate can be a bar code readable by infrared light.

Maruyama et al. teach that bar codes that are invisible to the naked eye but whose information can be identified by infrared rays are printed with an ink containing indium-tin oxide which is an infrared-absorbing compound (col. 1, lines 14-54).

It would have been obvious to one of ordinary skill in the art to have provided the carrier substrate with a bar code readable by infrared light by printing the carrier with ink containing IR

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components, as Maruyama et al. teach that bar codes that can be identified by infrared rays, yet invisible to the naked eye, are printed with an ink containing indium-tin oxide which is an infrared-absorbing compound.

Providing the carrier substrate of suitable material such as paper, into which the epoxy or polyester can flow, or resin sheet, as claimed in Claims 12 and 13, would have been obvious to one of ordinary skill in the art, as Bianco discloses that the carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material.

(13)

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 11 above, and further in view of Taggart 2003/0217802.

Taggart teaches that in making automotive structures from composite blanks, the blanks are properly identified using inkjet and/or bar code tracking technology [0060].

It would have been obvious to one of ordinary skill in the art to have used the method of the references as combined to provide bar code identification on composite automotive components, as taught by Taggart, to properly identify composite blanks for making automotive structures. The use of the method of the references as combined to make bar codes integral with automotive composite components would have been obvious to one of ordinary skill in the art to provide identification for making automotive structures from the components, as suggested by Taggart.

(14)

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of Takada 5,118,930.

Bianco discloses a method of embedding identification means in an article comprising: providing a carrier substrate with readable information; placing the carrier substrate on a base such as fiberglass; and coating the carrier substrate and base with a layer of epoxy or polyester material so that the substrate becomes an integral part of the fiberglass article. The carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material. The identification means on the carrier substrate can be a bar code placed on a reflective metal layer if the article is not inherently reflective. Bianco discloses applying a reflective metal layer to the carrier substrate to make the substrate reflective but does not disclose making the carrier substrate retroreflective.

Takada teaches that to make a bar code readable from greater distances, the light reflected from the bar code should be concentrated in a predetermined direction to prevent scattering. Takada teaches that retro reflected light from a retroreflective surface has more intensity than light reflected from a surface that does not contain retroreflective material, thereby increasing the distance at which a bar code can be read (col. 1, line 26 – col. 2, line 2).

It would have been obvious to one of ordinary skill in the art to have modified the method of Bianco for embedding a bar code in an article by printing the bar code on a retroreflective carrier substrate, as taught by Takada, to make the bar code readable from greater distances.

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Providing the carrier substrate of suitable material such as paper into which the epoxy or polyester can flow, as claimed in Claim 16, would have been obvious to one of ordinary skill in the art, as Bianco discloses that the carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material.

(15)

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 11 above, and further in view of Taggart 2003/0217802.

Taggart teaches that in making automotive structures from composite blanks, the blanks are properly identified using inkjet and/or bar code tracking technology [0060].

It would have been obvious to one of ordinary skill in the art to have used the method of the references as combined to provide bar code identification on composite automotive components, as taught by Taggart, to properly identify composite blanks for making automotive structures. The use of the method of the references as combined to make bar codes integral with automotive composite components would have been obvious to one of ordinary skill in the art to provide identification for making automotive structures from the components, as suggested by Taggart.

Conclusion

(16)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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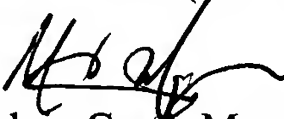
(17)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234.

The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
May 19, 2005